

Application No. 09/880,556

Reply to Office Action dated February 23, 2004

### **REMARKS/ARGUMENTS**

In response to the Office Action dated February 23, 2004, Applicants respond as follows. This response is timely in view of the fact that Applicants were provided 30 days or one month from the date of the Office Action in which to respond, whichever time period was the longer of the two.

Applicant has amended the claims in accordance with 37 CFR § 1.173 as requested by the Examiner. The scope of coverage has not changed from the prior filed Amendment, but merely the format of the claims has been revised in accordance with the Examiner's kind suggestion.

In response to the rejection regarding the Oath and Declaration, Applicants are in the process of securing a revised Oath and Declaration in accordance with the Examiner's request to address this concern. Applicants apologize for the delay, however the signatories are located in the United Kingdom and at least one of them has been hospitalized and in ill health. Applicants anticipate submitting the revised Oath and Declaration shortly.

Regarding the rejection of claims 12-13 and 17-32 under 35 U.S.C. § 251 as being based upon new matter, Applicants submit that one skilled in the art would readily be able to practice the invention as claimed, particularly in view of the Harris Declaration previously submitted. Applicants therefore respectfully request that this rejection be withdrawn.

Applicants respectfully traverse the ground of rejection that Applicants are using hindsight and directs the Examiner's attention to the Harris declaration. Mr. Harris is an

expert in the coatings field and has more than 58 years in the coating industry. In view of the substantial evidence presented by Mr. Harris as to what one skilled in the art would be able to practice based on the present disclosure, Applicant submits that the claims are fully capable of being practiced.

Regarding the rejection that Applicants are adding subject matter by mentioning specific anti-bacterial agents and putting the reader of the patent specification to undue burden by the breadth of the claims, Applicants traverse that rejection on at least the following two grounds. First, the specification says that the skilled reader would be able to identify materials of biocide by "routine experimentation," see the bottom of page 2 of the original specification. Second, U.S. Patent No. 6,093,407 discloses the use of many biocides which Applicants contend are properly part of the Brodie and Clover invention. Applicants are attempting to institute an interference with this application on the ground that Applicants were the first to conceive and reduce to practice Applicants' claimed invention. The biocides in the '407 patent are identified by chemical name and trade mark. This demonstrates that they have been in the public domain for some time. Further, the examples in this patent show that the testing is all routine.

Applicants have also endeavored to clarify the claims as amended above and submits that all claims are in compliance with 35 U.S.C. §§ 112 and 251.

On the issue of improper recapture, Applicants also respectfully traverse the ground of rejection that Applicants are attempting to recapture relinquished subject matter. The cited art in the parent application dealt with compositions which contained **inorganic**

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biocides. The claims of the parent application were allowed because inorganic biocides were excluded and that was the purpose of the amendment which Applicants made at that time. Applicants do not in the present application attempt to recapture that subject matter by asking for patent coverage for inorganic biocides and for this reason, Applicants request that this ground of rejection be withdrawn.

Regarding the rejection of claims 17 and 28 for double patenting, Applicant submits that the scope of these claims is based upon Applicants' disclosure and that in an interference, even as a junior party, Applicants should be entitled to demonstrate that in fact, they were the first to conceive and reduce to practice the invention claimed in claims 17 and 28.

Applicants respectfully request reconsideration of the amended application but request that reconsideration take place after Applicants submit the supplemental amendment and revised Oath and Declaration as set forth in the Office Action.

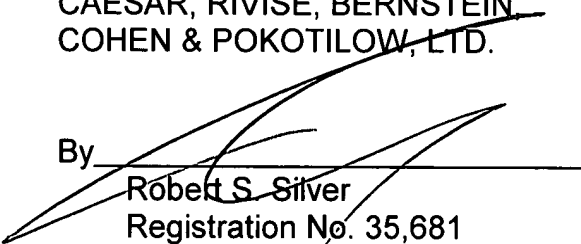
Respectfully submitted,

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March 24, 2004

Please charge or credit our Account  
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